

**R E M A R K S**

Claims 49-57 and 59-61 are pending and under examination. The Examiner has withdrawn Claims 59, 60, and 61 as allegedly being directed to a non-elected invention. (MPEP § 821.03). Claims 49, 50, and 52-57 stand rejected under 35 U.S.C. § 112, first paragraph, for allegedly failing to adequately describe the claimed invention. Claims 49, 50, and 52-57 stand rejected under 35 U.S.C. § 112, first paragraph, for allegedly failing to enable one skilled in the art to make and use the invention commensurate in scope with the present claims. None of the pending Claims stand rejected in view of the prior art. Claim 51 stands allowed.

In this communication, Applicants have canceled Claims 49, 50, 54, and 59-61 in order to further define one embodiment of their invention and to further their business interests and the prosecution of the present application in a manner consistent with the Patent Business Goals (PBG),<sup>1</sup> and not in acquiescence to the Examiner's arguments and while reserving the right to prosecute the original (or similar) claims in the future. Accordingly, the Applicants have amended Claims 52, 53, 55, and 56 to remove dependency upon canceled claims.

Also in this communication, Applicants have amended Claim 57 to further define one embodiment of their invention and to further their business interests and the prosecution of the present application in a manner consistent with the PBG, and not in acquiescence to the Examiner's arguments and while reserving the right to prosecute the original (or similar) Claim 57 in the future. None of the changes made to Claim 57 add new matter. None of the claim amendments or cancellations are intended to narrow the scope of the pending claims within the meaning of *Festo*<sup>2</sup>.

In conformity with current U.S. Patent and Trademark Office rules set forth in 37 C.F.R. § 1.121(c)(1)(i-ii), the Applicant have attached hereto (at Appendix 1) a separate sheet entitled "Version With Markings To Show Changes Made" to present the various changes

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<sup>1</sup> 65 Fed. Reg. 54603 (September 8, 2000).

<sup>2</sup> *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, No. 95-1066, 2000 WL 1753646 (Fed. Cir. 2000).

made to pending Claims 52, 53, 55, 56, and 57. For the Examiner's convenience, the Applicants have also attached hereto (at Appendix 2) a clean version of the entire set of pending Claims as amended by this communication.

Applicants note that the above-mentioned application claims priority to SUSPENDED U.S. Patent Application Serial No.: 08/826,577 ("577"). Notice of the proposed Claim amendments mentioned herein and a courtesy copy of the pending SUSPENDED Claims of the '577 application were sent to Examiner Robert C. Hayes, Ph.D., on August 20, 2001.<sup>3</sup> Applicants herein provide an additional copy of the SUSPENDED Claims in the '577 application for the Examiner's convenience. (*See*, Appendix 3).

**The Present Claims Satisfy The  
Written Description Requirement Of 35 U.S.C. § 112**

Claims 49, 50, and 52-57 stand rejected under 35 U.S.C. § 112, first paragraph, for allegedly failing to adequately describe the invention presently being claimed. Briefly, the Examiner argues that the Applicant is not entitled to claim nucleic acids encoding portions of the amino acid sequence of SEQ ID NO:2 because "one skilled in the art cannot reasonably visualize or predict what critical nucleic acids residues would structurally characterize the genus." (*See*, Office Action, pages 4-5). Applicant respectfully disagrees.

Nonetheless, the Applicants have canceled Claims 49, 50, and 54 without prejudice. Thus, the rejection as to Claims 49, 50, and 54 is moot. Claims 52, 53, 55, and 56 have accordingly been amended to remove dependency upon the canceled claims.

Currently pending Claims 52, 53, 55, 56, and 57 currently depend from allowed Claim 51. Claim 51 recites, in pertinent part, "[a]n isolated nucleic acid that encodes a polypeptide comprising the amino acid sequence shown in SEQ ID NO:2." Accordingly, the Applicants submit that pending Claims 52, 53, 55, 56, and 57 are free of the Examiner's concerns regarding claims encompassing nucleic acids encoding portions of SEQ ID NO:2. In view of

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<sup>3</sup> Notice that the '577 application was SUSPENDED was mailed on June 3, 1999. Notice that Claims 42, 45, 48, and 56 of the '577 application were Allowable was also mailed on June 3, 1999. Applicants have not been updated on the status of the SUSPENDED '577 application since their November 9, 1999, Status Inquiry letter.

the amendments and remarks presented above, Applicants respectfully request withdrawal of the present rejection.

**The Present Claims Satisfy The  
Enablement Requirement Of 35 U.S.C. § 112**

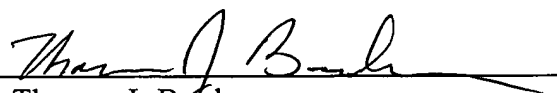
Claims 49, 50, and 52-57 stand rejected under 35 U.S.C. § 112, first paragraph, as allegedly not being enabled by the specification. The Examiner argues that the rejected claims encompass portions of the nucleic acid recited in SEQ ID NO:1 that encode portions of the amino acid recited in SEQ ID NO:2 that are not functionally characterized. (*See*, Office Action, pages 6-7). Applicants respectfully disagree.

Nonetheless, as mentioned above, the Applicant has canceled Claims 49, 50, and 54 without prejudice. Thus, the rejection as to Claims 49, 50, and 54 is moot. Pending Claims 52, 53, 55, and 56 have been amended to remove the dependency from the canceled claims. Pending Claims 52, 53, 55, and 56, and 57 currently depend from allowed Claim 51. Also as mentioned above, Claim 51 recites a nucleic acid that encodes a polypeptide comprising the sequence of SEQ ID NO:2. Applicants thus submit that pending Claims 52, 53, 55, and 56, and 57 are free of the Examiner's concerns regarding claimed subject matter encompassing portions of the nucleic acid sequence of SEQ ID NO:1 that encoding portions of the amino acid sequence of SEQ ID NO:2. Applicants respectfully request this rejection be withdrawn.

**CONCLUSION**

For the reasons set forth above, it is respectfully submitted that Applicants' claims should be passed to allowance. Should the Examiner believe that a telephone interview would aid in the prosecution of this application, Applicants encourage the Examiner to call the undersigned collect at (608) 218-6900.

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